



11 FEB 2009

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

NXP, B.V.
NXP INTELLECTUAL PROPERTY DEPARTMENT
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE CA 95131

In re Application of: BUCHHOLD, ET AL. :
U.S. Application No.: 10/581,219 :
PCT Application No.: PCT/IB2004/052546 :
Int. Filing Date: 25 November 2004 : DECISION
Priority Date: 04 December 2003 :
Atty Docket No.: DE 03 0409 US1 :
For: MAGNETIC FIELD SENSITIVE SENSOR :
ARRANGEMENT :

This is in response to the Applicants' request for reconsideration filed 22 September 2008 regarding a Notification of Defective Response concerning the declaration of the inventors filed on 16 August 2007. This request is being treated under 37 CFR 1.181.

BACKGROUND

This international application was filed on 25 November 2004, and claimed an earliest priority date of 04 December 2003 and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 01 June 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight on 04 June 2006. Applicants' filed, *inter alia*, the basic national fee on 08 June 2006.

On 01 March 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants', requiring the submission of an oath or declaration compliant with 37 CFR 1.497 (a) and (b).

Applicant submitted a declaration on 16 August 2007.

On 30 June 2008, a Notification of Defective Response was mailed to applicants', with the Notification stating that the declaration was non-compliant with 37 CFR 1.497(a) and (b) since it appeared to be a composite declaration.

DISCUSSION

Applicant submits that the Notification of Defective Response requiring an oath or declaration in compliance with 37 CFR 1.497 (a) and (b) is in error and points to an example of a defective declaration as discussed in MPEP 201.03 (II) (B). Applicant further states that the declaration of 16 August 2007 contrasts with this example in that all the co-inventors reviewed the requisite declaration document and each inventor was not named separately.

Inspection of the declaration filed 16 August 2007 reveals three inventors (Buchhold, Doescher, and Butzmann). A document providing consent of the assignee was also submitted on 16 August 2007 and was executed by all three inventors. However, the declaration is defective in that it appears to have been compiled by aggregating sheets from multiple declaration documents to arrive at a single composite document. Page 1 of the declaration provides statements that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought, and that the specification of which was filed as a PCT international application number PCT/IB2004/052546 on 25 November 2004. Accordingly, since a complete declaration document for each inventive entity (Buchhold and Doescher) and (Butzmann) was not submitted, the declaration is considered unexecuted.

MPEP 201.03 explains in part:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

In view of this policy, it would not be appropriate to accept the declaration filed on 16 August 2007. Further, Applicant's request for consideration did not cure previously noted defects as outlined in the Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of Defective Response (Form PCT/DO/EO/916) and the period for response (including availability of extensions of time) in both of these notifications has expired. Accordingly, the application is abandoned.

CONCLUSION

For the reasons above, applicant's request for reconsideration is **DISMISSED WITHOUT PREJUDICE**, and the application is abandoned.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Katherine Moran/
PCT Legal, Detailee
571-272-6095

A handwritten signature in black ink, appearing to read "Leonard Smith", with a long, sweeping horizontal stroke extending to the right.

Leonard Smith
PCT Legal Examiner